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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,989	09/26/2001	Roland N. Walker	12160.2	2969

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EXAMINER

BAHTA, ABRAHAM

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/964,989	Applicant(s) WALKER, ROLAND N.	
	Examiner Abraham Bahta	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 16-20, 25 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 11-15, 21-23, 26-30, 35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 35 and 36 contain terms that are internally inconsistent. It appears that applicant intends to refer to each of the flowers in a group of flowers. Therefore, the following suggestion is made for claim 35 and 36. Claim 35 would be best described if re-written as A product comprising: a group of flowers and a repeatable, identical, pad-printed image provided on each of the flowers in the group of flowers, said image selected from the group of, a depiction; a communication from a sender of the group of flowers to an individual recipient of the group of flowers; a personalized communication and a general message to the recipient in general and a commemoration of an event. The applicant is requested to make similar correction to claim 36.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 US 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the invention of carrying out his invention.

Claims 11 and 35-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. On page 7, line 21 through page 8,

line 2 the specification recites the image may be provided onto an organic product in variety of manners, for example, the images may be printed, painted, sprayed, copied, transferred, etched, embossed, engraved, scratched, stamped, cut, imprinted, scored, carved or otherwise marked into at least a portion of an organic product; however, claims 11 and 35-36 recite each of the group of flowers is free from etching or cut designs. The applicant is reminded that a negative limitation recited in the present claims, which did not appear in the specification as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 US 112, (*In re Anderson*, 471 F. 2d. 1237, 176 USPQ 331 (CCPA 1973)). There is no clear support for this negative limitation.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 11-15, 21-23, 26-30 and 35-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27 and 37-39 of copending Application No. 11/061788 in view of 5,142,976. The claims of the subject application recite an organic product comprising a group of flowers wherein each of the flowers comprises pad printed image and the claims of the copending application recite an organic product having a printable surface wherein an image is printed onto the printable surface. Although, the claims of the copending application do not recite the image is pad printed, Roulleau '976 teaches an organic product in which the surface of the organic product is pad printed. See co.; 1, lines 61-65. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized pad-printing technique to the organic product recited in the claims of the subject application because Roulleau '976 teaches a pad printed image can be applied to an organic product.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-15 and 21-23, 26-30 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (USP 6,172,328) or Skonecki (USP 5,305,550) in view of Roulleau '976.

Jones teaches an organic product such as a leaf/ flower petals which may be in a natural configuration (see Fig. 1 and col. 3, lines 43-45) in which the organic product may be marked/etched with a device/laser/galvanometer. The marking may be a message of greeting, expression, identification, information, communication, inscription and advertisement. See col. 1, lines 54-65; col. 3, lines 21-49 and col. 4, lines 21-27. Further, Jones's flower/petal/leaf is natural because Jones is concerned regarding the ability of the leaf to photosynthesize and respire even when the design is provided on the surface of the flower. See col. 3, lines 38-44. Therefore, it is the position of the Examiner that the flower is in an undamaged form.

Skonecki teaches an organic product such as fresh natural flower, such as a rose in a natural configuration in which the product is provided with a personalized message or drawing inscribed on one of its petals. See col. 1, lines 24-38.

Jones or Skonecki do not require pad-printed image; however, Roulleau '976 teaches an organic product in which the surface of the product comprises pad printed image. See col. 1, lines 61-65.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the organic product of Jones or Skonecki with a pad printed image so as not damage, or etch or cut the surface of the organic product

when the image is printed on the surface of the organic product and in order to provide the surface of the organic product with a repeatable and identical image.

Regarding claims 15 and 27, patentability of product-by-process claims is based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Regarding claims 14, 26 and 28-30, Jones teaches the ornament design or marking formed on the flower/petal may be a message, greeting, expression, identification, information, communication, inscription, advertisement, bar code, inventory marking price information or business message. See Jones col. 3, lines 21-38. In addition, Skonecki teaches the inscription may be personalized message such as the word "congratulations". See Skonecki fig. 1.

Response to Applicant's Argument's/Remarks

Applicant's arguments with respect to claims 11-15, 21-23, 26-30 and 35-36 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication should be directed to Abraham Bahta whose telephone number is (571) 272-1532. The Examiner can normally be reached Monday-Friday from 11:30 AM -8:00 PM (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the examiner supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. Bahta

09/29/055



JENNIFER MCNEIL
PRIMARY EXAMINER

10/03/05